

AMENDMENTS TO THE DRAWINGS

The attached Replacement Sheets include changes to FIGs. 1-4. These Replacement Sheets replace the original sheets containing FIGs. 1-4. The changes to the figures are discussed on pages 24-25 of the Amendment.

Attachments: Four (4) Replacement Sheets - Amended FIGs. 1-4

REMARKS

Applicants acknowledge receipt of the Office Action mailed January 21, 2010.

In the Office Action¹, the Examiner provided his claim interpretations; objected to claims 4-7, 12-16, 19, 20, 22-25, 32, and 40-71; objected to the drawings; objected to the specification; rejected claims 1-32 and 40-71 under 35 U.S.C. § 112, second paragraph; rejected claims 1, 2, 40, and 41 under 35 U.S.C. § 102(b) as being anticipated by *Orimo et al.* (U.S. Patent No. 4,338,279); and rejected claims 1-32 and 40-71 under 35 U.S.C. § 102(b) as being anticipated by a human accommodating building in developed countries (such as a building including a science laboratory).

In this Amendment, Applicants amend the specification, claims 1, 4-20, 22-26, 28, 30-32, 40-59, 61-64, 67, and 69-71, and FIGs. 1-4. Claims 1-71 remain pending, with claims 33-39 withdrawn from consideration. Of the claims under examination, claims 1 and 40 are independent.

The originally-filed specification, claims, abstract, and drawings fully support the amendments to the specification, claims 1, 4-20, 22-26, 28, 30-32, 40-59, 61-64, 67, and 69-71, and FIGs. 1-4. No new matter has been introduced.

Based on the foregoing amendments, Applicants traverse the objections and rejections above and respectfully request reconsideration for at least the reasons that follow.

¹ The Office Action contains characterizations of the claims and the related art with which Applicants do not necessarily agree. Unless expressly noted otherwise, Applicants decline to subscribe to any statement or characterization in the Office Action.

I. CLAIM INTERPRETATIONS

Regarding claims 1-32 and 40-71, the Examiner provides his interpretation of the claim limitations and indicates which limitations will/will not be given patentable weight. Although Applicants do not necessarily agree with the Examiner's interpretations and assertions, Applicants have amended claims 1, 4, 7, 9-11, 18, 22, 23, 32, 40, 43, 46, 48-50, 57, 61, 62, and 71 in order to positively recite limitations, which should now be given patentable weight.

Applicants further submit that with respect to claims 1 and 40, where the Examiner asserts that "the term 'section' does not inherently impart any specific structural requirement . . . The element was interpreted to mean a portion of the housing that may be used for processing a sample" (*Office Action*, p. 3, para. 5), Applicants agree with the Examiner's interpretation of the term 'section'.

With respect to the Examiner's assertion that "[c]laims 4 and 43 do not positively set forth 'an air inlet/outlet manifold,' 'a laboratory facility accommodating the apparatus' or 'the building accommodating the laboratory' as part of the claimed subject matter" (*Office Action*, p. 3, para. 6), Applicants submit that the recited structures further define where the external sensors of the sensor device, which are positively recited, may be located. The recited structures are located outside the claimed apparatus.

With respect to the Examiner's assertion that "[r]egarding claims 18 and 57, the characteristics of air flowing into apparatus are not structures, and they do not further structurally limit the apparatus or the opening" (*Office Action*, p. 4, para. 11), Applicants have amended claims 18 and 57 to define that the inside climate of the air, including the

air temperature, pressure, air flow rate, and humidity, in the interior space can be accurately controlled with the air manipulation device.

II. OBJECTIONS TO THE CLAIMS

Claims 40-71 stand objected to under 37 CFR 1.75 as being a substantial duplicate of claims 1-32. (*Office Action*, p. 4, para. 14). Although Applicants do not necessarily agree with the Examiner's assertion, Applicants have amended independent claim 40 in an effort to expedite prosecution.

Further, regarding the objections to claims 4-7, 12-16, 19, 20, 22-25, 32, 41, 46, 51-55, 58, 63, 64, and 71, the objections have been rendered moot by the amendments to those claims. Applicants therefore request that the objections to claims 40-71 be withdrawn.

III. OBJECTIONS TO THE DRAWINGS

The drawings stand objected to under 37 C.F.R. § 1.83(a) because the drawings must show every feature of the invention specified in the claims. (*Office Action*, p. 5, para. 17). Specifically, the Examiner alleges that "sensor(s); . . . [.] 'a plurality of covers' . . . [.] 'a plurality of interior spaces of the apparatus' . . . [.] 'fan' . . . [.] and 'opening' must be shown or the feature(s) canceled from the claim(s)." *Id.* In response, Applicants have amended FIGs. 1-4. Applicants submit that the features identified above are supported in the figures as follows: (1) "sensors": illustrated as element 124 in FIGs. 2 and 3; (2) "plurality of covers": illustrated as element 40 in FIG. 1; (3) "plurality of interior spaces of the apparatus": illustrated as elements 5a and 5b in FIGs. 1 and 2; (4) "fan": illustrated as element 83 in FIG. 4; and (5) "opening": illustrated as element 123 in FIG. 3.

Applicants request that the Replacement Sheets be made of official record in the above-identified patent application, and that the drawing objections be withdrawn. No new matter has been introduced. If the drawings for any reason are not in full compliance with the pertinent statutes and regulations, please advise the undersigned.

IV. OBJECTION TO THE SPECIFICATION

The specification stands objected to as allegedly failing to provide proper antecedent basis for the claimed subject matter. (*Office Action*, p. 6, para. 19). Specifically, the Examiner alleges, "[t]he specification lacks antecedent basis for the claimed terminology, 'fan in an opening' in claims 17 and 56." *Id.* Applicants submit that the objection to the specification has been rendered moot by the amendments to the specification. Applicants therefore request that the objection to the specification be withdrawn.

V. 35 U.S.C. § 112, SECOND PARAGRAPH, REJECTIONS

Claims 1-32 and 40-71 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential elements, such omission amounting to a gap between the elements. (*Office Action*, p. 6, para. 21). Specifically, the Examiner alleges "[t]he omitted element is: a computer/processor/software for controlling the climate control device." *Id.* Although Applicants do not necessarily agree with the Examiner's assertion, Applicants have amended independent claims 1 and 40 to include a "data processing device."

Claims 1-32 and 40-71 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being incomplete for omitting essential structural cooperative relationships

of elements . . . Specifically, the Examiner alleges that “[t]he omitted structural elements and their cooperative relationships are: at least a relationship between the housing-cover[r] and the climate control device.” (*Office Action*, p. 7, para. 22). Although Applicants do not necessarily agree with the Examiner’s assertion, Applicants have amended independent claim 1, and similarly independent claim 40 to recite, *inter alia*, “a cover for protecting said at least one sample processing section in said housing, said cover enclosing the sample processing section and defining an interior space between the housing and the cover; [and] at least one climate control device for controlling the environment within said interior space defined by the cover.”

Claims 1-32 and 40-71 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention. (*Office Action*, p. 7, para. 23). Applicants submit that the rejection of claims 1, 4-7, 10-20, 22, 23, 25, 28, 30-32, 40, 43-46, 49-59, 61, 62, 64, 67, and 69-71 has been rendered moot by the amendments to those claims.

With respect to the Examiner’s assertion that “[r]egarding claims 1, 8, 40, and 47, the term ‘section’ does not inherently impart any specific structural requirement” (*Office Action*, p. 7, para. 23), Applicants agree with the Examiner’s interpretation of the term ‘section,’ as discussed above in the “Claim Interpretations” section.

With respect to the Examiner’s assertion that “[r]egarding claims 20 and 59, it is unclear how: (a) device is capable of recycling air for humidity, temperature and toxic control; (b) a device is capable of removing toxic elements from the air to be recycled;

and (c) a device is capable of supplying humidity to the air to be recycled and/or a heater/cooling device capable of controlling the temperature of the air to be recycled" (*Office Action*, p. 8, ll. 26-30), Applicants have amended claims 20 and 59 to delete the "capable of" language and instead recite "a device for" Applicants further submit that the devices cited above are a type of "climate control device." Accordingly, the devices may be located in a position similar to where the "climate control device" 121 is located in Applicants' FIG. 3.

With respect to the Examiner's assertion that "[r]egarding claims 26 and 65, it is unclear if 'a humid filter' is a moist filter, or it is a filter that is designed to filter out moisture" (*Office Action*, p. 9, ll. 21-22), Applicants submit that the claims explicitly recite that the humid filter ensures "high and uniform humidity in the chamber when the inflowing air is drawn through the humid filter device." Accordingly, the humid filter is a moist filter which maintains high and uniform humidity.

Applicants therefore request that the rejection of claims 1-32 and 40-71 under 35 U.S.C. § 112, second paragraph, be withdrawn.

VI. 35 U.S.C. § 102(b) REJECTIONS

Claims 1, 2, 40, and 41 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Orimo*. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that the claims are patentably distinguishable over *Orimo* at least for the reasons set forth below.

In order to properly establish that *Orimo* anticipates Applicants' claimed invention under 35 U.S.C. § 102, each and every element of each of the claims in issue must be disclosed, either expressly described or under principles of inherency, in that single

reference. Furthermore, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." See M.P.E.P. § 2131, quoting *Richardson v. Suzuki Motor Co.*, 868 F.2d 1126, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Independent claim 1, and similarly independent claim 40, recites an apparatus for automatic processing of at least one biological sample accommodated on at least one slide, comprising: "at least one climate control device for controlling the environment within said interior space defined by the cover; a sensor device for providing feedback signals to the climate control device; and a data processing device for controlling the at least one climate control device and for storing a processing protocol, the processing protocol defining a predetermined amount of reagents to be applied in a predetermined sequence on the at least one slide."

Orimo, however, fails to teach or suggest, at least, an apparatus for automatic processing of at least one biological sample accommodated on at least one slide, comprising: "at least one climate control device for controlling the environment within said interior space defined by the cover; a sensor device for providing feedback signals to the climate control device; and a data processing device for controlling the at least one climate control device and for storing a processing protocol, the processing protocol defining a predetermined amount of reagents to be applied in a predetermined sequence on the at least one slide," as recited in independent claim 1, and similarly independent claim 40 (emphases added).

The Examiner alleges that "Orimo discloses . . . at least one climate control device configured to control the environment within said interior space (C14/L19-44)." (*Office Action*, p. 10, para. 25). Applicants respectfully disagree. As disclosed in

column 14, lines 28-32 of *Orimo*, "[a] preheating device (107) is provided to heat the diluent to a temperature near the desired reaction temperature and comprises a heater, a temperature sensor, and a temperature control circuit." *Orimo* fails to disclose wherein the preheating device (107), which the Examiner appears to equate to the claimed "climate control device," controls the environment within the chemical analyzing apparatus. Rather, the preheating device 107 merely controls the temperature of the diluent, not the environment, such as the temperature and humidity of the air, within an interior space of the chemical analyzing apparatus. *Orimo* also fails to disclose a data processing device including a processing protocol defining a predetermined amount of reagents to be applied in a predetermined sequence on at least one slide.

Orimo therefore fails to disclose each and every element of each of the claims, either expressly or inherently. See M.P.E.P. § 2131. Accordingly, independent claims 1 and 40, and claims 2 and 41 which correspondingly depend from claims 1 and 40, are patentable over *Orimo*. Applicants therefore request that the rejection of claims 1, 2, 40, and 41 under 35 U.S.C. § 102(b) be withdrawn.

Claims 1-32 and 40-71 stand rejected under 35 U.S.C. § 102(b) as being anticipated by a human accommodating building in developed countries. Applicants respectfully disagree with the Examiner's arguments and conclusions and submit that the claims are patentably distinguishable over the human accommodating building at least for the reasons set forth below.

As discussed above, independent claim 1, and similarly independent claim 40, recites an apparatus for automatic processing of at least one biological sample

accommodated on at least one slide, comprising: "at least one climate control device for controlling the environment within said interior space defined by the cover; a sensor device for providing feedback signals to the climate control device; and a data processing device for controlling the at least one climate control device and for storing a processing protocol, the processing protocol defining a predetermined amount of reagents to be applied in a predetermined sequence on the at least one slide."

The Examiner alleges that "[r]egarding claims 1-32 and 40-71, a human accommodating building comprises: a housing frame; at least one sample processing section, said at least one sample processing section is provided within said housing (kitchens, refrigerators or laboratories); a cover, said cover enclosing the sample processing section and defining an interior space between the housing and the cover (door to the kitchens, refrigerators or laboratories); at least one climate control device configured to control the environment within said interior space (an air conditioning (AC) unit or a sprinkler system, for instance); [and] a sensor device capable of providing feedback signals to the climate control means (a thermostat and etc.)." (*Office Action*, p. 11, ll. 11-22). Such teachings, even if present in a human accommodating building, which Applicants do not necessarily concede, however, fail to teach or suggest "a data processing device for controlling the at least one climate control device and for storing a processing protocol, the processing protocol defining a predetermined amount of reagents to be applied in a predetermined sequence on the at least one slide." The air conditioning (AC) unit or the sprinkler system, which the Examiner equates to the claimed "climate control device," cannot practically and logistically be controlled by a data processing device which also stores a processing protocol defining a

predetermined amount of reagents to be applied in a predetermined sequence on at least one slide.

The human accommodating building therefore fails to disclose each and every element of each of the claims as amended, either expressly or inherently. See M.P.E.P. § 2131. Accordingly, independent claims 1 and 40, and claims 2-32 and 41-71 which correspondingly depend from claims 1 and 40, are patentable over the human accommodating building. Applicants therefore request that the rejection of claims 1-32 and 40-71 under 35 U.S.C. § 102(b) be withdrawn.

VII. CONCLUSION

Applicants respectfully submit that claims 1-32 and 40-71 are in condition for allowance.

In view of the foregoing amendments and remarks, Applicants respectfully request reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account 06-0916.

Respectfully submitted,

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Dated: June 7, 2010

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Attachments: Four (4) sheets of drawings, containing amended FIGs. 1-4